

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MARY K. MCCARTY, VICKIE PORTWOOD KRUGER,  
SHERE LYNNE ANDERSEN and DAVID A. REYNOLDS

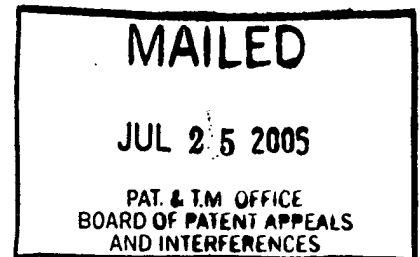
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Appeal No. 2005-0969  
Application 09/378,678

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ON BRIEF

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Before THOMAS, NAPPI, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 6-32. Claims 1-5 and 33-35 have been canceled.

### **Invention**

Appellants' invention relates to a method and system for producing combined social expression cards and gift certificates for delivery to recipients. According to the present invention, the term gift certificate includes all items or indicia that may be exchanged for goods or services, including, but not limited to in store certificates, coupons, stored value cards, and the like. The present invention is preferably implemented in a Web-based client-server environment in which remotely located customers use standard Web browsers to access a Web server. The Web server presents a remotely located customer with a selection of social expression card designs and a selection of gift certificates. In response to customer selection of a card design and a gift certificate, the system of the present invention delivers a combined social expression card and gift certificate to a recipient designated by the customer. Delivery according to the present invention may be accomplished either by printing and mailing a physical product to the recipient or by delivering an electronic version to the recipient.

The present invention enables a customer to select a gift certificate by displaying to the customer a list of merchants from which gift certificates are available. The merchants may be

national, regional, or local. In order to enable a customer to select a merchant located near the recipient, the customer may access a list of locations for a selected merchant. Preferably, the system of the present invention displays a list of states in which the selected merchant has at least one location. In response to customer selection of state from the list of states, the system displays a list of locations for the selected merchant within the selected state. Appellants' specification at page 2, line 29, through page 3, line 30.

Claim 30 is representative of the claimed invention and is reproduced as follows:

30. A method of providing combined social expression cards and gift certificates, which comprises the computer implemented steps of:

presenting a remotely located user with a selection of social expression card designs;

displaying to said remotely located user a list of merchants from which gift certificates are available;

in response to user selection of a merchant from said list of merchants, displaying a list of locations for said selected merchant;

presenting said remotely located user with a selection of gift certificates available from said selected merchant;

in response to user selection of a card design and a gift certificate, delivering a combined social expression card and gift certificate to an addressee designated by said remotely located user.

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### References

The references relied on by the Examiner are as follows:

Small	5,513,117	Apr. 30, 1996
Christensen et al. (Christensen)	5,710,886	Jan. 20, 1998

Borders.com: PR Newswire, "Borders.com Online Gift Center Rescues Last-Minute Holiday Shoppers," 04 December 1998, Dialog file 20 #03654067;1pg.

Borders.com: Internet Archive Wayback Machine;  
[www.archive.org/](http://www.archive.org/);  
[www.boarder.com/](http://www.boarder.com/) 11 January 1998;  
[http://web.archive.org/web/\\*/http://www.borders.com;2pgs.](http://web.archive.org/web/*/http://www.borders.com;2pgs.)

Borders.com: Internet Archive Wayback Machine;  
[www.archive.org/](http://www.archive.org/);  
[www.borders.com/](http://www.borders.com/) 11 January 1998;  
<http://web.archive.org/web/19980111035340/http://borders.com;1pg>

Borders.com: Internet Archive Wayback Machine;  
[www.archive.org/](http://www.archive.org/);  
[www.borders.com/](http://www.borders.com/) 11 January 1998;  
<http://web.archive.org/web/19980111035542/borders.com/stores/index.html;2pgs.>

Borders.com: Internet Archive Wayback Machine;  
[www.archive.org/](http://www.archive.org/);  
[www.borders.com/](http://www.borders.com/) 11 January 1998;  
<http://web.archive.org/web/19980111040641/borders.com/stores/states/va.html;2pgs.>

PR Newswire; "Nordstorm Launches Online Store at [www.nordstorm.com/](http://www.nordstorm.com/)" 21 October 1998, Dialog File 20#031757781.

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### **Rejections At Issue**

Claims 6-7, 16-20, 25-27, and 29-32 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Small and a collection of papers regarding Borders.com (hereinafter referred to as Borders).

Claims 21-24 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Small and Borders and official notice.

Claim 28 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Small and Borders and Christensen et al. (hereinafter Christensen).

Claims 8-15 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Small and Borders and PR Newswire.<sup>1</sup>

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<sup>1</sup> We noted that the Examiner erroneously included claims 10-11 in the Small and Borders rejection applied to claim 30. This error was recognized on appeal by both Appellants and the Examiner. See page 6 of the answer and the claim groupings at page 4 of the brief. For purposes of this appeal, we treat claims 10-11 as rejected on the same grounds as claim 8 from which they depend.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.<sup>2</sup>

### OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 6-7 and 16-32 under 35 U.S.C. § 103, and we reverse the Examiner's rejection of claims 8-15 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

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<sup>2</sup>Appellants filed a supplemental appeal brief ("the brief" hereinafter) on July 19, 2004 replacing the appeal brief filed on May 17, 2005. Appellants filed a reply brief on October 1, 2004. The Examiner mailed an Examiner's Answer on July 27, 2004.

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Appellants have indicated that for purposes of this appeal the claims stand or fall together in two groupings:

Claims 6-7 and 16-32 as Group I; and

Claims 8-15 as Group II.

See page 4 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 4-6 of the brief and pages 1-3 of the reply brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

*Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the two groups noted above, and we will treat:

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Claim 30 as a representative claim of Group I; and

Claim 8 as a representative claim of Group II.

**I. Whether the Rejection of Claims 6-7 and 16-32 Under  
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 6-7 and 16-32. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants.



**Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 30, Appellants argue at pages 4-5 of the brief, "[t]he Examiner has not pointed to any teaching or suggestion or motivation in either reference to make the asserted combination" and neither Small nor Borders teach launching a list of merchant locations in response to selection of a merchant from a list of merchants.

We find Appellants' arguments unpersuasive. We address Appellants' second argument first. Small teaches listing merchants and selecting from the list at column 6, lines 6-12. Small then teaches at column 7, lines 36-45, that the gift card

includes redemption instructions (91) and a toll free number (92) for accessing the gift. That is, Small teaches displaying nonfunctional descriptive material in the form of information 91 and 92 (on the card) in response to selection of a merchant from a list of merchants. Small does not teach nonfunctional descriptive material in the form of merchant locations. However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive

material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

As to Appellants' first argument, we address it even though its deemed to be moot in view of our nonfunctional descriptive material discussion above. Although we find the Examiner's statement of motivation to be weak at best, we also find that the Borders PR Newswire reference speaks for itself on the issue of motivation. As the Borders PR Newswire reference states, should the gift purchaser desire to visit the store, there is a store locator function. Although Appellants have included merchant location information for the convenience of the gift recipient, this is not the sole reason that such information make be

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desired. We find more than sufficient motivation to combine the references that is taught in the references themselves.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

**II. Whether the Rejection of Claims 8-15 Under  
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 8-15. Accordingly, we reverse.

With respect to dependent claim 8, Appellants argue at page 5 of the brief, the "single sentence [of the Nordstrom reference] does not suggest the invention as claimed in any of claims 8-15," and the Nordstrom reference "is silent as to how the multiple shipment feature is invoked." We agree. We have reviewed the reference and do not find the claimed features therein. We find the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

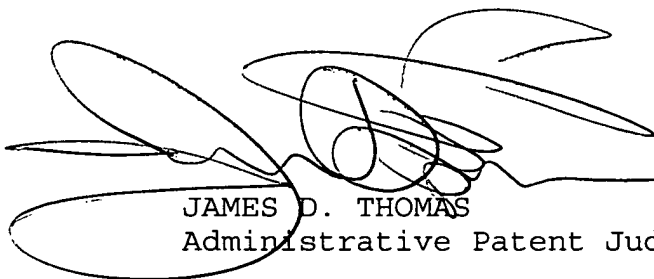
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### Conclusion

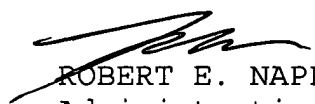
In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 6-7 and 16-32, and we have not sustained the rejection under 35 U.S.C. § 103 of claims 8-15.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

### AFFIRMED-IN-PART



JAMES D. THOMAS )  
Administrative Patent Judge )  
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ROBERT E. NAPPI )  
Administrative Patent Judge )  
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ALLEN R. MACDONALD )  
Administrative Patent Judge )  
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